

REMARKS

Please reconsider this application in view of the above amendments and the following remarks. Applicants thank the Examiner for carefully considering the application.

Disposition of Claims

Claims 1, 5, 6, and 28-36 were pending in the application. Claims 5, 30, and 34 are hereby cancelled without prejudice or disclaimer. Accordingly, claims 1, 6, 28-29, 31-33, and 35-36 remain pending. Claims 1, 29, and 33 are independent. The remaining claims depend either directly or indirectly from independent claims 1, 29, and 33.

Claim Amendments

Independent claims 1, 29, and 33 are hereby amended to incorporate the limitations of now-cancelled claims 5, 30, and 34, respectively. These amendments do not introduce any new subject matter, and no new search should be required, as the amendments are merely a formality to incorporate previously examined limitations into the independent claims.

Examiner Interview

Applicants thank the Examiner and his supervisor for the courtesies extended during the Examiner Interview conducted May 13, 2008. The arguments discussed during the Examiner Interview were substantially similar to those presented herein. No agreement was reached.

Objection to the Specification

The Examiner has objected to the specification as failing to provide proper antecedent for said claim limitation “a computer usable medium” recited in independent claim 29. *See* Office Action dated February 25, 2008, p. 3. This objection is respectfully traversed.

The specification as filed states, “A procedure, computer executed step, logic block, process, etc., are here, and generally, conceived to be self-consistent sequences of steps or instructions leading to a desired result.” Further, claims 21-27 were directed to a “machine readable medium having embodied thereon a computer program for processing by a machine....” Although claims 21-27 are no longer pending, claims 21-27 nonetheless contribute to the subject matter of the specification as filed.

In view of the above, one of ordinary skill in the art would appreciate that the terms “machine readable medium” and “computer usable medium” are essentially interchangeable and refer a computer-readable storage medium such as a compact disc, flash drive, or hard disk. The “steps or instructions” described in the specification would necessarily be stored on such a medium. In fact, a computer-implemented invention cannot exist without some type of medium used to store instructions executed by the processor. If required by the Examiner, Applicants are prepared to submit signed affidavits by skilled practitioners attesting to this fact. Therefore, the specification as filed clearly provides sufficient antecedent basis for the term “computer usable medium.” Withdrawal of the objection is respectfully requested.

Rejections under 35 U.S.C. § 103

“Obviousness [under 35 U.S.C. § 103] is a question of law based on underlying factual inquiries.” MPEP § 2141. Specific factual inquiries for determining obviousness were laid out in *Graham v. John Deere Co. (Graham)*, 383 U.S. 1, 148 USPQ 459 (1966), and reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007). “The question of obviousness must be resolved on the basis of these factual determinations. While each case is different and must be decided on its own facts, the *Graham* factors, including secondary considerations when present, are the controlling inquiries in any obviousness analysis.” MPEP § 2141.

MPEP § 2143 states that “[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” Further, when combining prior art elements, the Examiner “must articulate the following: (1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference....” MPEP § 2143(A).

Claims 1, 5, 29, 30, 33, and 34

Claims 1, 5, 29, 30, 33, and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication 2004/0030795 (“Hesmer”) in view of U.S. Patent Publication 2005/0096019 (“Ndili”) and U.S. Patent Publication 2002/0107891 (“Leamon”). The rejection is moot with respect to now-cancelled claims 5, 30, and 34. To the extent that the rejection may still apply to the amended claims, the rejection is respectfully traversed.

Amended independent claims 1, 29, and 33 recite, in part, “wherein the rendering engine creates the third markup using a file path pointing to the device-specific markup language.” The term “file path” is a well-known term of art that refers to the location of a file in a directory system. This definition is entirely consistent with Applicants’ use of the term. *See* specification as filed, *passim*. Therefore, amended independent claims 1, 29, and 33 require that the rendering engine creates the third markup using *the location of the device specific markup language in a directory system*. *See, e.g.*, specification as filed, p. 15, lines 5-12.

The Examiner has suggested that paragraph [0020] and Figure 2A of Leamon teach these limitations. *See* Office Action dated February 25, 2008. To the contrary, the cited passage is completely silent with respect to any sort of file path. In fact, Leamon does not teach any sort of file path whatsoever. Hesmer and Ndili are also completely silent with respect to file paths. Further, even assuming *arguendo* that the references teach the general concept of a file path, none of the references teach “a file path *pointing to the device-specific markup language*” as required by amended independent claims 1, 29, and 33.

Moreover, Applicants submit that the use of a file path is not inherently required by the use of a markup language. For example, a markup language may be stored in a database or dynamically constructed in memory (for example, using an XML API and/or segments of other markup languages stored in memory) without specifically using “a file path pointing to the device-specific markup language.” “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.... ‘In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.’” MPEP § 2112(IV), citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Therefore, absent any specific disclosure, the cited references cannot expressly or inherently teach “a file path pointing to the device-specific markup language.”

In view of the above, Hesmer, Ndili, and Leamon clearly do not include each element of amended independent claims 1, 29, and 33. Further, Applicants submit that the differences between the cited art and the claimed invention are non-obvious. Accordingly, amended independent claims 1, 29, and 33 are patentable over the cited art for at least the reasons given above, and withdrawal of the rejection is respectfully requested.

Claims 6, 31, and 35

Claims 6, 31, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hesmer in view of Ndili, Leamon, and U.S. Patent 6,781,609 (“Barker”). To the extent that the rejection may still apply to the amended claims, the rejection is respectfully traversed.

As noted above, Hesmer, Ndili, and Leamon do not teach “wherein the rendering engine creates the third markup using a file path pointing to the device-specific markup language.” Further, Barker does not supply what Hesmer, Ndili, and Leamon lack. Barker is completely silent with respect to any sort of file path, much less “a file path pointing to the device-specific markup language.” Therefore, Barker cannot possibly teach “wherein the rendering engine creates the third markup using a file path pointing to the device-specific markup language.”

In view of the above, Hesmer, Ndili, Leamon, and Barker clearly do not include each element of claims 1, 29, and 33. Therefore, Hesmer, Ndili, Leamon, and Barker also do not include each element of claims 6, 31, and 35, which depend directly from amended independent claims 1, 29, and 33. Accordingly, claims 6, 31, and 35 are patentable over the cited art for at least the reasons given above, and withdrawal of the rejection is respectfully requested.

Claims 28, 32, and 36

Claims 28, 32, and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hesmer in view of Ndili, Leamon, and U.S. Patent Publication 2004/0205567 (“Nielsen”). To

the extent that the rejection may still apply to the amended claims, the rejection is respectfully traversed.

As noted above, Hesmer, Ndili, and Leamon do not teach “wherein the rendering engine creates the third markup using a file path pointing to the device-specific markup language.” Further, Nielsen does not supply what Hesmer, Ndili, and Leamon lack. Nielsen is completely silent with respect to any sort of file path, much less “a file path pointing to the device-specific markup language.” Therefore, Nielsen cannot possibly teach “wherein the rendering engine creates the third markup using a file path pointing to the device-specific markup language.”

In view of the above, Hesmer, Ndili, Leamon, and Nielsen clearly do not include each element of claims 1, 29, and 33. Therefore, Hesmer, Ndili, Leamon, and Nielsen also do not include each element of claims 28, 32, and 36, which depend directly from amended independent claims 1, 29, and 33. Accordingly, claims 28, 32, and 36 are patentable over the cited art for at least the reasons given above, and withdrawal of the rejection is respectfully requested.

Conclusion

Applicants believe this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 03226/511001; SUN030087).

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